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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,485	03/26/2001	Kazuhiko Sugiyama	KOKU-0004	9172

7590 06/29/2005

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/817,485	Applicant(s) SUGIYAMA ET AL.	
	Examiner Vanel Frenel	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05072001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Application filed on 03/26/01. Claims 1-15 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al (4,831,526) in view of (The spider in the web...or how not to get snared using the Internet by Kowatch, Diana, Rough Notes.Indianapolis: Apr 1996. Vol.139, Iss.4; pg.28, 2 pgs).

(A) As per claim 1, Luchs discloses comprising: selecting at least one activity from a set of predetermined activities on the Internet for insurance coverage (See Luchs, Col.13, lines 3-28), selecting an insurance coverage amount from a set of predetermined amounts for the selected Internet activities (See Luchs, Col.13, lines 3-28); calculating a premium amount for an insurance purchaser based upon at least a combination of the selected insurance coverage amount and the selected Internet activities (See Luchs, Col.13, lines 3-28); and submitting the premium to an insurance provider (See Luchs, Col.17, lines 5-38).

Luchs does not explicitly disclose a method of selling and buying insurance for damages to computer files caused by the Internet-related activities and the predetermined activities bearing a certain risk of causing damage to the computer files.

However, these features are known in the art as evidenced by Diana. In particular, Diana teaches a method of selling and buying insurance for damages to computer files caused by the Internet-related activities (See Diana, Page 3, Paragraphs 12-Page 4, Paragraph 9) and the predetermined activities bearing a certain risk of causing damage to the computer files (See Diana, Page 4, Paragraphs 1-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Diana within the system of Luchs with the motivation of providing the Internet which provides fascinating new potential for business if handled with care, common sense, and accountability (See Diana, Page 1, Paragraph 2).

(B) As per claim 2, Diana discloses the method of selling and buying insurance for damages to computer files caused by the Internet activities wherein the predetermined activities on the Internet include down-loading a file from a web site, opening e-mail, opening e-mail attachments, searching information from web sites and copying a file from a secondary storage medium, any one of the predetermined activities inducing a transfer of an undesirable destructive computer virus (See Diana, Page 3, Paragraphs 4-6).

The motivation for combining the teachings of Luchs and Diana are as given above in the rejection of claim 1, and incorporated herein.

(C) As per claim 3, Diana discloses the method of selling and buying insurance for damages to computer files caused by the Internet activities wherein the secondary storage medium includes a floppy disk, a zip disk and a CD (See Diana, Page 2, Paragraph 16).

The motivation for combining the teachings of Luchs and Diana are as given above in the rejection of claim 1, and incorporated herein.

(D) As per claim 4, Diana discloses the method of selling and buying insurance for damages to computer files caused by the Internet activities further comprising: selecting a discount feature from a set of predetermined conditions, the predetermined conditions including a maximal number of performing the selected Internet activities, an existing anti-virus program and an existing firewall (See Diana, Page 4, Paragraphs 1-9); and adjusting the premium amount based upon the selected discount feature (See Diana, Page 4, Paragraphs 1-9).

The motivation for combining the teachings of Luchs and Diana are as given above in the rejection of claim 1, and incorporated herein.

(E) As per claim 5, Luchs discloses the method of selling and buying insurance for damages to computer files caused by the Internet activities further comprising: reporting a damage caused by the selected Internet activities to the insurance provider (See

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Luchs, Col.13, lines 3-28) ; and making a claim for the damage*for reimbursement (See Luchs, Col.13, lines 3-28).

(F) As per claim 6, Diana discloses the method of selling and buying insurance for damages to computer files caused by the Internet activities wherein the premium is periodically adjusted based upon a number of the insurance purchasers and a number of the claims (See Diana, Page 1, Paragraphs 2-4 through Page 2, Paragraph 1).

The motivation for combining the teachings of Luchs and Diana are as given above in the rejection of claim 1, and incorporated herein.

(G) As per claim 7, Diana discloses the method of selling and buying insurance for damages to computer files caused by the Internet activities further comprising: providing service from the insurance provider to repair the damage to the computer files (The Examiner interprets security and protection for ourselves and customers to be a form of repairing the damage to the computer files (See Diana, Page 4, Paragraphs 1-5).

The motivation for combining the teachings of Luchs and Diana are as given above in the rejection of claim 1, and incorporated herein.

(H) As per claim 8, Diana discloses the method of selling and buying insurance for damages to computer files caused by the Internet activities further comprising: making a monetary payment to the insurance purchaser for restoring the damage to the computer files (The Examiner interprets security and protection for ourselves and customers to be

a form of repairing the damage to the computer files (See Diana, Page 4, Paragraphs 1-5).

The motivation for combining the teachings of Luchs and Diana are as given above in the rejection of claim 1, and incorporated herein.

(I) As per claim 9, Luchs discloses comprising: a first user input module for selecting at least one activity from a set of predetermined activities on the Internet for insurance coverage (See Luchs, Col.13, lines 3-28), a second user input module for selecting an insurance coverage amount from a set of predetermined amounts for the selected Internet activities (See Luchs, Col.13, lines 3-28); a processing module connected to said first user input module and said second user input module for calculating a premium amount for an insurance purchaser based upon at least a combination of the selected insurance coverage amount and the selected Internet activities (See Luchs, Col.13, lines 3-28); and a premium payment module for connected to said processing module for submitting the premium to an insurance provider (See Luchs, Col.17, lines 5-38).

Luchs does not explicitly disclose a system for selling and buying insurance for damages to computer files caused by the Internet-related activities and the predetermined activities bearing a certain risk of causing damage to the computer files.

However, these features are known in the art as evidenced by Diana. In particular, Diana teaches a method of selling and buying insurance for damages to computer files caused by the Internet-related activities (See Diana, Page 3, Paragraphs

12-Page 4, Paragraph 9) and the predetermined activities bearing a certain risk of causing damage to the computer files (See Diana, Page 4, Paragraphs 1-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Diana within the system of Luchs with the motivation of providing the Internet which provides fascinating new potential for business if handled with care, common sense, and accountability (See Diana, Page 1, Paragraph 2).

(J) Claims 10-15 recite the underlying process of the elements of claims 2-6 respectively. As the various elements of claims 2-6 have been shown to be either disclosed by or obvious in view of the collective teachings of Luchs and Diana, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 10-15 are rejected for the same reasons given above for method claims 2-6 and incorporated herein.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches Insurance industry databases, Database; Weston; Oct/Nov 1998; Julia Dorn; Sally K. Ritter and The Atlanta Journal –Constitution; Personal Technology Tech Report On Technology Store your data backups off-site on the Internet by Bill Husted Staff Writer. The Atlanta Journal Constitution (PRE-1997 Fulltext). Atlanta, Ga: Jun 9, 1996.pg. H.02.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F

June 18, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
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